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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,900

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Jeffrey Niederst

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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

07/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,900	Applicant(s) NIEDERST, JEFFREY	
	Examiner Elena Tsoy Lightfoot	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-27, drawn to a method of imparting corrosion resistance to a score line of an easily openable metal can end.

Group II, claim 28, drawn to an easily openable can end prepared by the method of claim 1.

Group III, claim 29, drawn to an easily openable can end having a score line coated with a radiation cured coating of claim 1.

Group IV, claim 30, drawn to a metal container having an easily openable can end prepared by the method of claim 1.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: Groups I-IV lack unity of invention because even though the inventions of these groups require a radiation-curable coating composition of claim 1, this technical feature shared by the groups is not a special technical feature as **it does not make a contribution over the prior art** in view of Watt (US 3936557). The shared technical feature lacks novelty because a radiation-curable coating composition of claim 1 is anticipated by Watt. Watt describes a radiation-curable coating composition comprising a blend of epoxide materials

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such as an epoxy prepolymer of the type of glycidyl-bisphenol A resins (claimed difunctional compound) (See column 2, lines 53-65), polyglycidyl ethers (claimed polyfunctional reactive diluent) (See column 3, lines 56-60), blended with a low viscosity monoepoxide (claimed monofunctional reactive diluent) in limited proportions, and a cationic polymerization initiator (See Abstract). The composition may contain 1,2-epoxybutane (See column 5, lines 26-42) as a low viscosity monoepoxide in an amount of e.g. **1.3%** (Example 9), **11.1%** (Examples 10-11) or **7.1%** (Example 12). It is held that the groups of claims lack unity of the invention if the technical feature shared by groups does not make a contribution over the prior art. See form paragraph 18.07.02. For these reasons the unity does not exist between the groups of claims.

A telephone call was made to Mr. James J. Napoli on June 30, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Species of Group I

The application contains a plurality of disclosed patentably distinct species of:

(A) **a difunctional compound:** (i) a diepoxy compound (Claims 8-10), (ii) a vinyl epoxy compound (Claims 8, 11, 12), (iii) a divinyl compound (Claims 8 and 13), or a mixture thereof (Claim 8). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

(B) **a photoinitiator** comprising: (i) a sulfonium salt (Claims 16, 17, 26), an iodonium salt (Claims 16, 17, 26), a thermally-blocked acid catalyst (Claims 16, 17, 27), or a

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mixture thereof (Claim 16). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

(C) **a monofunctional reactive diluent** comprising: (i) an alcohol (Claims 18 and 20), (ii) a glycol ether (Claims 18 and 20), an epoxy compound (Claims 18-19), or a mixture thereof (Claims 18-20). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR

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1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

July 23, 2009

/Elena Tsoy Lightfoot/